

REMARKS

Status of the Claims

Pending claims

Claims 1, 27, 31, 34, 38 to 42, 45, 48, 50, 52, 54, 56, 57, 59, 60, 91, 92, 95, 96, 98, 100, 102 to 104, 106, 108 to 112, 116, 120 to 122, 126, 131, 141, 146, 162 to 164, 173, 175 to 178, 180, 181, 187, 189, 197, 199 to 206, 209 to 211 and 213, are pending.

Claims canceled and added

In the instant amendment, claims 116 and 120 to 122 are canceled, without prejudice or disclaimer. Claims 221 and 222 are newly added. Accordingly, claims 1, 27, 31, 34, 38 to 42, 45, 48, 50, 52, 54, 56, 57, 59, 60, 91, 92, 95, 96, 98, 100, 102 to 104, 106, 108 to 112, 126, 131, 141, 146, 162 to 164, 173, 175 to 178, 180, 181, 187, 189, 197, 199 to 206, 209 to 211, 213, 221 and 222 will be pending after entry of this amendment.

Support for the Claim Amendments

The specification sets forth an extensive description of the invention in the amended claims. For example, support for the amended claims can be found in the claims as filed. Support for claims directed to oil well drilling, fracturing or treatment can be found on at least page 209, lines 12 to 21. Accordingly, Applicants respectfully submit that no new matter is introduced by the instant amendment.

Group Election, with traverse

The Office alleges that the instant application is directed to 5438 separate inventions for the reasons stated on pages 2-8 of the OA and that restriction is required under 35 U.S.C. § 121 and 372.

Applicants herein elect Group 278, drawn to an isolated, synthetic or recombinant polypeptide of SEQ ID NO:38 having glucanase activity, with traverse, where reasons for traversal are set forth below.

Applicants expressly reserve their right under 35 U.S.C. § 121 to file a divisional application directed to the nonelected subject matter during the pendency of this application, or an application claiming priority from this application.

Rejoining process claims under In re Ochiai

After the elected product claims of Group 278 have been found to be allowable, all withdrawn process (methods) claims which depend from or otherwise include all of the limitations of the allowed product claims should be rejoined. MPEP §821.04, §821.04(a), §821.04(b); pgs 800-64 to 800-71, 8th Edition, rev. 5, vol. 1, August 2006; In re Ochiai, 37 USPQ2d 1127 (Fed. Cir. 1995); In re Brouwer, 37 USPQ2d 1663 (Fed. Cir. 1995); 1184 OG 86, 3/26/96.

Reasons to reconsider and withdraw restriction requirement

Applicants respectfully request the Patent Office reconsider and withdraw the restriction requirement for the following reasons:

This application is a § 371 national stage application

This application is a national stage application claiming benefit of priority under 35 U.S.C. § 371 to International Application Number PCT/US2004/021492, filed in accordance with Patent Convention Treaty (PCT) rules on July 2, 2004. Accordingly, the election/restriction for this national stage application is evaluated under:

*PCT RULE 13
Unity of Invention*

*PCT RULE 13.1.
Requirement*

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").

PCT RULE 13.2.

Circumstances in Which the Requirement of Unity of Invention Is To Be Considered Fulfilled
Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Further direction is provided in MPEP 1893.03(d) (MPEP Eighth Ed, Rev. 3, Aug. 2005, page 1800-200, 201):

MPEP 1893.03(d) Unity of Invention [R-2] - 1800 Patent Cooperation Treaty

A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. For example, a corresponding technical feature is exemplified by a key defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with the claimed key.

Applicants respectfully aver that after entry of this amendment all pending claims in this application will satisfy PCT Rule 13.2 in that they will share a single inventive concept based on a genus of polypeptides exemplified by SEQ ID NO:38, encoded e.g., by the genus of nucleic acids exemplified by SEQ ID NO:37.

Election of Group 278, with traverse

The Office alleges that the Groups do not share a special technical feature, because the Groups do not claim a feature which defines a contribution over the prior art as the claims are allegedly anticipated by the Poole et al. reference (see, e.g. page 8 of the OA). Poole (UniProt Accession No. P23660) is allegedly 62.6% identical to SEQ ID NO:2. Applicants respectfully aver that the Poole reference does not anticipate the claimed invention. The claims, upon entry of the instant amendment, are directed polypeptides having at least 80% sequence identity to SEQ ID NO:38 and to nucleic acids having at least 80% sequence identity to SEQ ID NO:37. As such, after entry of the instant amendment, all pending claims will share a special technical feature that is based on a genus of polypeptides exemplified by SEQ ID NO:38, encoded e.g., by the genus of nucleic acids exemplified by SEQ ID NO:37.

Applicants respectfully aver that after entry of the instant amendment all pending claims in this application will share a common “unity of invention” under PCT Rule 13.2. Accordingly, Applicants respectfully request the Patent Office to withdraw the restriction requirement, in part, and rejoin Groups 19, 537, 796, 1055, 1314, 1573, 1832, 2091, 2609, 2868, 3127, 3386, 3644, 3903, 4162, 4421, 4480, 4939, and 5198.

CONCLUSION

Applicants respectfully aver that the all claims pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 50-0661** referencing docket no. D1150-7N. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

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By: /Lynn M. Linkowski/

Lynn M. Linkowski
Registration No.: 47,320

VERENIUM CORPORATION
(Customer No.: 45975)
Intellectual Property Department
P.O. Box 910550
San Diego, CA 92191-0550
USA

Phone: (858) 526-5450
Fax: (858) 526-5950
Email: lynn.linkowski@verenium.com